

FILE

Office Action Summary

Application No.

09/287,632

Applicant(s)

Waterhouse et al.

Examiner

Karen A. Lacourciere

Group Art Unit

1635



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11, 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-38 is/are pending in the application

Of the above, claim(s) 13-21 and 24-38 is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-12, 22, and 23 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 8, 9, 10

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Application/Control Number: 09/287,632

Page 2

Art Unit: 1635

DETAILED ACTION

Election/Restriction

Applicant's election of Group I in Paper No. 12 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Applicant's argument that Group I and Group II are drawn to the same invention is found to be persuasive. Therefore, Group I, claim 1, is rejoined with the elected group, Group II.

Claims 13-21 and 24-38 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. Election was made **without** traverse in Paper No. 12.

Information Disclosure Statement

Reference WO 98/05770 on PTO form 1449, filed 07-06-2000, has not been considered because an English translation was not provided. Reference AU 20891/97 was only considered with respect to the abstract, as only the abstract was provided.

Art Unit: 1635

Claim Objections

Claim 22 is objected to because of the following informalities: Claim 22 consists of two sentences. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 is indefinite because it appears to be a claim drawn to a composition, but also recites a method step in the last two lines of the claim. It is unclear whether the claim is drawn to a composition or a method. For the purposes of examination of the instant case, it has been assumed that claim 22 is intended to be drawn to a composition and the last two lines of the claim are assumed to be the result of a word processing error and have been disregarded.

Claims 1, 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1635

Claim 1 is indefinite due to the recitation "essentially similar to at least part". One skilled in the art would not know what nucleotides are encompassed by this term. Claims 11 and 12 are indefinite for the same reasons, due to their dependence on claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 3, 7, 8, 11, 12, 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Metzloff et al. (submitted on PTO form 1449, filed 07-06-2000).

Metzloff et al. disclose a method wherein a foreign transgene, *chsA*, has been introduced into petunia plants under control of the 35S promoter from cauliflower mosaic virus. This construct produces an RNA molecule comprising a region of 43 base pairs with 80% homology with the *chsA* coding and 3'-UTR regions. This region is located near the base of a loop connecting the base-paired strands. Expression of this RNA results in cosuppression of *chsA*, resulting in a phenotypic color change. Therefore, Metzloff et al. anticipates claims 1-3, 7, 8, 11, 12, 22 and 23.

Art Unit: 1635

Claims 1- 6, 9-12, 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Agrawal et al.


Agrawal et al. disclose methods for reducing the expression of a gene using an antisense oligonucleotide which comprises a self complementary region and wherein the self complementary region comprises at least 10 complementary nucleotides and wherein the self complementary region is complementary to a target gene. These methods are disclosed for use in a plant, are disclosed as having loop regions connecting the complementary regions, and result in the phenotypic inhibition of the target gene. Therefore, Agrawal et al. anticipates claims 1-3, 5, 11, 12, 22 and 23.

Any inquiry concerning this communication should be directed to Karen A. Lacourciere at telephone number (703)308-7523.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Elliott can be reached at (703) 308-4003. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Karen A. Lacourciere
July 28, 2000


SEAN MCGARRY
PATENT EXAMINER
JUL 28 2000